

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application of: David B. Riffer
Serial No.: 10/680,840
Filing Date: October 7, 2003
Confirmation No.: 5411
Title: PLASTIC CLOSURE WITH COMPRESSION
MOLDED SEALING/BARRIER LINER
Attorney Docket: 17155-03
Group Art Unit: 1791
Examiner: M. J. Daniels

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On December 8, 2008
(Date)

REPLY TO SECOND EXAMINER'S ANSWER

Since the filing of the Reply to the first Examiner's Answer there has been a change in the Real Party In Interest. The assignee of the present application Owens-Illinois Closure Inc. is now, by change of name, Rexam Closure Systems Inc., a wholly owned subsidiary of Rexam Plastic Products Inc., which is a wholly owned subsidiary of Rexam Inc.

Applicant's basic position is set forth in the Appeal Brief filed July 3, 2006 and the first Reply filed October 6, 2006. This second Reply is addressed to the arguments presented by the Examiner in the second Answer mailed October 20, 2008.

All independent claims 1, 24 and 32 argued in the present Appeal are rejected over Mori 4,312,824 as the primary reference, Mehra 5,700,412 as the secondary reference and Hundt 3,147,874 as the tertiary reference. Schrenk 5,380,497 is cited as a fourth reference, in combination with Mori, Mehra and Hundt, in rejecting claim 24.

The Examiner has now conceded that the primary Mori reference does not inherently disclose a method for achieving a layered liner construction as recited in the application claims, as previously contended. (Second Answer page 21, 4th full paragraph). The primary issue on appeal is whether any aspect or limitation of the present invention as claimed is "inherent in Mehra's method," as contended at page 5, lines 6-7 of the second Answer.

It is well established that alleged inherency is a question of fact, and that it is incumbent upon the Examiner to provide evidence and reasoning to support any alleged inherency. *Ex parte Levy*, 17 USPQ2d 1461 (BPAI 1990); *Ex parte Skinner*, 2 USPQ2d 1785 (BPAI 1987). Moreover, alleged inherency must be certain, and cannot be established by probabilities or speculation. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999); *Ex parte Cyba*, 155 USPQ 756 (POBA 1967); *Ex parte Keither*, 154 USPQ 320 (POBA 1967). Alleged inherency is not

a matter of “interpretation.” Indeed, “a retrospective view of inherency is not a substitute for some teaching or suggestion [in the prior art].” *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). The initial burden of establishing a *prima facie* basis to support a rejection based upon alleged inherency rests on the Examiner. *Ex parte Levy, supra*. The Examiner must provide a basis in fact and/or technical reasoning to support a contention that the allegedly inherent characteristic necessarily flows from the prior art. *Id.* This standard clearly has not been met in the present application in connection with the citation of Mehra.

The Mehra reference is discussed in detail at pages 6-7 of applicant’s Appeal Brief. The Mehra patent discloses a process for making a laminar article in which a polyolefin, a barrier polymer and a compatibilizer are blended and heated to form a heterogeneous melt. The heterogeneous melt is “stretched” by squeezing between rollers, pressing between platens, extruding between die lips, or by blow molding. The resulting product is a “heterogeneous blend” that comprises the polyolefin as a matrix, the compatibilizer, and the barrier resin in the form of discrete - i.e., non-continuous - “regions, domains, particles or platelets, these words being used interchangeably” (column 2, lines 36-47). This “heterogenous blend” of discrete particles in Mehra is not even remotely related to providing a compression mold charge that includes “layers of matrix polymer material alternating with layers of barrier polymer material” as recited in claim 1, for example. Nor is the “stretching” of the heterogeneous blend in Mehra in any way related to the step of compression molding a mold charge to form a liner “having layers of barrier polymer material alternating with layers of matrix polymer material” as recited in claim 1, for example. Similar recitations in claims 24 and 32 likewise are not “inherent in Mehra’s method,” or in any way disclosed or suggested in Mehra, alone or in combination with Mori.

Mehra clearly and unequivocally teaches a process that results in a heterogeneous dispersion of “platelets” in a polymer matrix, which is hardly the same as or equivalent to alternating layers as recited in claims 1, 24 and 32. For example, in the “summary of invention” at column 2, lines 1-17, Mehra states that a barrier polymer is melted in a first extruder, a compatibilizer is melted in a second extruder, and the two melt streams are combined in a spin head. The combined melt stream is then cut into pellets, which are then blended with particles of polyolefin, heated to form a heterogeneous melt, and this heterogeneous melt is stretched to form platelets. (The difference between “stretching” and “compression molding” is fully addressed in applicant’s Appeal Brief.) Thus, the “platelets” in Mehra clearly are formed in the stretching operation, which takes place after forming the heterogeneous melt, and not during the extrusion operation as suggested by the Examiner. Furthermore, neither extrusion nor stretching is even remotely similar to compression molding for reasons set forth in detail in the paragraphs bridging pages 6 and 7 of applicant’s Appeal Brief. Moreover, a heterogeneous dispersion of “platelets” in a polymer matrix is hardly the same as or equivalent to alternating layers.

The purpose of citing the Hundt reference remains unclear. The statements of rejection combine Mori and Mehra, or Mori, Mehra and Schrenk, “as evidenced by Hundt.” However, the only specific teachings “evidenced” by Hundt cited in the second Answer are the fact that Hundt discloses a multilayer crown closure (second Answer page 5, lines 11-12) relative to claims 1 and 24, and that Hundt discloses a multilayer barrier fabricated by extrusion (second Answer page 8, line 17 relative to claim 24 and page 11, line 1 relative to claim 32). However, the present invention as claimed is directed to a method of making a closure (claims 1 and 24) or a liner (claim 32) in which alternate layers of resin and barrier material are formed by the recited step of

compression molding, not by separate fabrication or by layering as described by Hundt. Nor does Hundt combine with either Mori or Mehra inasmuch as neither Mori nor Mehra involves formation of “layers.” The Examiner suggests at page 17, 3rd full paragraph of the second Answer that Hundt is cited as “evidence regarding predictability and motivation.” However, Hundt does not “predict” that Mori combined with Mehra will yield alternate layers or alternate continuous layers in a compression molded liner, and does not “motivate” persons in the art to practice a method in no way suggested by Mori or Mehra.

Finally, regarding Schrenk 5,380,479 cited as a fourth reference relative to claim 24 (the need to pick and choose among four references is itself evidence of non-obviousness. *In re Herrick*, 3.44 F.2d 713, 717, 145 USPQ 400, 402 (CCPA 1965), quoting *Ball & Roller Bearing Co. v. F. C. Sanford Mfg. Co.*, 297 F. 163, 167 (2nd Cir. 1924) (“one good reference is better than 50 poor ones”)), the fact remains that Schrenk is essentially incompatible with Mehra in that Mehra relates to heterogeneous blends of discrete particles or platelets rather than alternating continuous layers of barrier and matrix polymer materials as recited in claim 24. In any event, the Schrenk reference adds nothing to Mori, Mehra and Hundt for reasons discussed in detail in the paragraph bridging pages 9 and 10 of the Appeal Brief.

In summary, independent claim 1 is allowable over the combination of Mori 4,312,824, Mehra 5,700,412 and Hundt 3,147,874 because these references, considered either individually or in combination, do not disclose or suggest a method of making a plastic closure by placing within the interior of the closure cap a mold charge that includes layers of matrix polymer material alternating with layers of barrier polymer material, and compression molding the mold

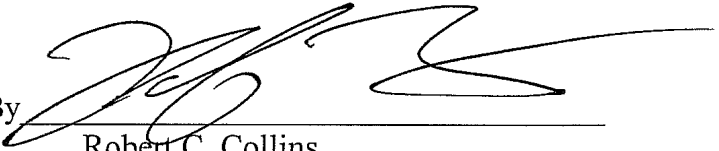
charge in situ within the cap interior to form a liner having layers of barrier polymer material alternating with layers of matrix polymer material.

Independent claim 24 is allowable over the combination of Mori, Mehra, Hundt and Schrenk 5,380,479 because these references do not disclose or suggest, individually or in combination, a method of making a plastic closure by extruding a mold charge that consists essentially of continuous layers of matrix polymer material alternating with continuous layers of barrier polymer material, totaling at least nine alternating layers, and compatibilizer material disposed in the matrix polymer material layers, the barrier polymer material layers or in separate layers between the matrix and barrier polymer material layers, and compression molding the mold charge in situ within the cap to form a liner having continuous layers of barrier polymer material alternating with continuous layers of matrix polymer material.

Independent claim 32 is allowable over the combination of Mori, Mehra and Hundt because these references do not disclose or suggest a method of making a liner for a plastic closure that includes extruding a pellet that consists essentially of a multiplicity of alternating layers of matrix polymer material and barrier polymer material, and compression molding the pellet to form a liner disc in which the alternating material layers are oriented generally parallel to the disc.

Please charge any fees associated with this submission to Account No. 50-4417 (Rexam Plastic).

Respectfully submitted,
REISING, ETHINGTON, BARNES,
KISSELLE, P.C.

By 

Robert C. Collins

Reg. No. 27,430

Telephone (248) 689-3500

Facsimile (248) 689-4071